

Remarks

Claims 1 – 33 are currently Pending.

Election/Restrictions

Examiner has issued a *restriction requirement under 35 USC 121* on a *national phase application of a PCT International Application*.

This application is a National Phase Application of PCT/IL04/000044 having an International Filing Date of 15th January 2004.

The Examiner is respectfully referred to the Manual for Patent Examining Practice (MPEP) 1893.03(d) Unity of invention [R3] which states:

Examiners are reminded that unity of invention (*not restriction*) practice is applicable in international applications (both Chapter I and II) *and in national stage applications submitted under 35 U.S.C. 371*. (Emphasis added).

According to the MPEP, Species Rejections can be made in a PCT National Phase Application, *provided that lack of unity of invention between the species is demonstrated*, as per MPEP 18.20, which mandates a specific form in which the rejection should be made, viz:

¶ 18.20 National Stage Election of Species in 35 U.S.C. 371 Applications

This application contains claims directed to more than one species of the generic invention. *These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.*

The species are as follows:

Here insert Species

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in

dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

However, instead of referring to unity of invention, the Examiner has referred to *a search and examination burden* (Page 3 last full paragraph). The search burden is relevant to restriction practice only, which is not allowed.

Indeed a search and examination burden is not a relevant criterion to unity of invention.

Furthermore, the Examiner explicitly refers on page 2 item 1, to the species being "patentably distinct". Unity of invention is *blind* to whether the species are patentably distinct, but is *only* interested in whether there is *a common inventive feature*.

Furthermore the Examiner refers on page 3 line 2 to invention II having "separate utility". Inventions may indeed have separate utility and still have unity of invention provided they share a unified inventive concept.

Examiner has *not argued* that the three species *lack a common inventive feature*. There is thus *no prima facie case* and hence *no obligation on the applicant* to make an election.

Use of restriction practice at the national phase is a breach of the PCT requirements.

Examiner is respectfully requested to *withdraw* the restriction requirement as it is *improper*.

Furthermore applicant is *not obligated* to make a restriction as *no prima facie case* has been raised.

On the contrary, there was an International Preliminary Examination Report, which *failed to find* lack of unity of invention.

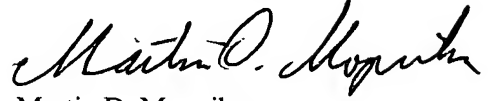
Thus in the present case there is *a prima facie case* based on the findings of the International Examiner that unity of invention *is present*.

Furthermore the International Examiner found in the International Preliminary Examination Report that claims 26 to 32 were allowable. Therefore there is *more than merely a prima facie case* that *alleged species III and IV are in fact a single allowable invention*.

That is to say, the lack of objection as to lack of unity at the International stage, combined with the finding of allowability of claims 26 to 32 as a single invention, is believed to have *created a presumption of unity of invention*.

Applicant respectfully awaits the first office action on the merits.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Martin D. Moynihan". The signature is fluid and cursive, with the first name "Martin" being the most prominent part.

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